

REMARKS

Claims 1-15 are pending herein.

I. The specification objections.

ok to enter -5/28/03 AJH A Substitute Specification has been respectfully supplied herewith as requested with a marked-up version showing the changes. No new matter has been added. The Examiner is respectfully requested to check that the Substitute Specification is properly processed.

II. The drawings rejections.

It is noted that Ref. Numeral 41 is properly disclosed at paragraph [0043] at page 8 of the specification.

All of the other Ref. Numerals (1, 6, 39, 40a, and 50) shown in the drawings, but not described in the specification have been respectfully described in the substitute specification. As the drawings show these items, a description added to the specification is respectfully not new matter because it merely represents that which is previously disclosed by the drawings.

Standard tape measure 1 has been amended at paragraphs [0007] and [0010] for example. Figures 3 and 4 disclose a standard prior art tape measure 1 inside a shell casing of the present invention in one embodiment.

Measuring tape 50 has been added to paragraph [0037] as shown in Fig. 2a.

Lead holder 6 has been added to paragraph [0038].

Stalk 40a has been added to paragraph [0038] as shown in Fig. 8.

Blade holder release knob 39 has been added to paragraph [0040] as shown in Fig. 6.

It is respectfully requested that these changes be entered. No new matter has been added.

III. The anticipation rejections under 102(e) and the obviousness rejections in view of published application US 2002/0073568 A1 to Johnson have been removed by the filing herewith of a 37 CFR 1.131 affidavit. See MPEP 715 "Swearing Back of Reference." See also MPEP 715.05.

The sworn affidavit of the sole inventor attached hereto respectfully satisfies the requirements of 37 CFR 1.131 for the following reasons:

1. the rejections are 102(e) rejections (or based on 102(e) for the 103 rejections).
2. the reference is not a 102(b) 1 year statutory bar reference.
3. The cited reference is not claiming the same invention (see claims of Johnson and MPEP 715.05). Applicant also notes that the Office Action would have had to note any USPTO allegation that the same invention is claimed. However, in any event, these are simple tape measure devices and a comparison of the claims shows the many differences as claimed. For example, claim 1 in the present invention claims a first and second concave shell with malleable interior sections with connection means to enclose a tape measure, i.e., a cover for an existing tape measure that fits over the cover of the existing tape measure. Nothing like this is claimed by Johnson.

DISCUSSION OF AFFIDAVIT

Applicant is a professional carpenter and reduced this simple device to practice in a working prototype prior to December 18, 2000 (the cited reference date) as stated in the Affidavit. Also, see also MPEP 715.07 at page 700-211 regarding proof "However, there are some devices so simple that a mere construction of them is all that is necessary to constitute reduction to practice." *In re Ahashi/America*. The present invention is a very simple to manufacture, tape measure based multi-function device, and /or tape measure surrounding casing. Therefore, the applicant was able to easily fashion his own working prototype prior to

December 18, 2000 as stated and evidenced in the Affidavit.

It is respectfully noted that applicant was careful not to offer his device for sale, or disclose it to the public or to use it in public, i.e., "public use" under 102(b), but instead only stated to STANLEY TOOLS (Exhibit A) and The PERFECT TAPE MEASURE COMPANY (Exhibit B) that he had built "a new kind of tape measure tool" and was inquiring about procedure, i.e., obtaining confidentiality agreements and patents, and only then potentially proceeding forward. Therefore, the invention was never offered for sale or disclosed for "public use" impermissibly under 35 USC 102(b). Therefore, these supporting references clearly demonstrate the prior invention conception and reduction to practice relevant time frames involved were all prior to December 18, 2000.

Subsequently, applicant diligently pursued a patent application in (see MPEP 715.07). For example a general practice law firm, Boiler & Kelly of Eugene, Oregon, (See Exhibit C, which is self-explanatory) was retained by applicant to draft a confidentiality agreement, so that the Perfect Tape Measure Company (see Exhibit B) could review parts of the prototype to determine the cost to manufacture parts of it, while the applicant retained the patent rights and other intellectual property rights. **Therefore, the prototype was confidentially disclosed to, and discussed by, applicant's attorneys at Boiler & Kelly in September of 2000, see Exhibit C which states "the prototype we discussed" as a supporting written statement.** Letters regarding finalizing the confidential agreement were still circulating in due course in 2001.

Also, in regard to diligence, applicant contacted the undersigned's office in February 2001 and commissioned our office to perform a professional prior art search (see check dated February 21, 2001 from the inventor to the Gerald H. Kiel, applicant's patent attorney of record at Reed Smith LLP undersigned below, and our acknowledgement letter of March 8, 2001 attached hereto).

Therefore, applicant has been diligently pursuing a patent (see MPEP 715.07).

The prior art search was extensive and was cited on the comprehensive IDS filed with the present application. Applicant knows the industry, and respectfully posits that given his own knowledge of the industry and prior art, and given the extensive prior art search he commissioned, it makes sense that a published application is the sole potential reference the Examiner can locate because the applicant believes that he is the first inventor.

Therefore, in accordance with MPEP 715.01, applicants have respectfully overcome the prior art rejections at paragraphs 3-11 which cited published application US 2002/0073568 A1 to Johnson having an effective date as a reference of December 18, 2000 as the primary reference relied upon. As the primary reference can no longer be used, all of the rejections are respectfully overcome by the Affidavit under 37 CFR 1.131.

If the Examiner requires additional proof, applicant can prepare a Supplemental Affidavit in short order. Please telephone applicant's attorney below if the affidavit is insufficient, and additional proof will be summarily submitted.

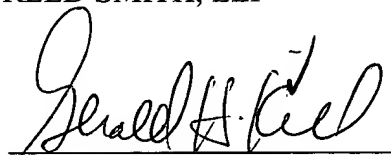
IV. Conclusion

In light of the *FESTO* case, no claim amendment or argument made herein was related to the statutory requirements of patentability unless expressly stated herein. No claim amendment or argument made was for the purpose of narrowing the scope of any claim unless Applicant has explicitly stated that the argument is "narrowing." Thus, the amendments herein were made for no more than a "tangential relation" for any equivalents unless explicitly stated that they were not a "tangential relation" reason for amendment or argument. Therefore, it is respectfully requested that all of the claims be reconsidered and allowed.

Please call the undersigned for any reason to expedite prosecution of this application.

April 7, 2003
599 Lexington Avenue, 29th floor
New York, NY. 10022
Tel. (212) 521-5400

Respectfully submitted,
REED SMITH, LLP

By: 
Gerald H. Kiel, reg. No. 25,116
Attorney for Applicants